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Confirmation No.: 4754

PTO/SB/97 (08-03)

Approved for use through 07/31/2006, OMB 0951-0031

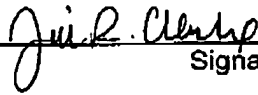
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence for U.S. Patent Application No. 10/054,498 filed January 22, 2002 in re John B. Welsh, et al. is being facsimile transmitted to the United States Patent and Trademark Office at facsimile number (703) 872-9306 on December 6, 2004.

Date



Signature

Jill R. Clarke

Typed or printed name of person signing Certificate

Customer No. 29490
Genomics Institute of the Novartis Research Foundation
Telephone: 858-812-1855
Fax: 858-812-1981

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Attachments:

1. Form PTO/SB/21 Transmittal Form (1 pg.);
2. Form PTO/SB/17 Fee Transmittal with authorization to charge Deposit Account No. 50-1885 in the amount of \$110 for one month extension of time (1 pg. + 1 pg. copy);
3. Response to Restriction Requirement mailed October 5, 2004 (6 pgs.); and
4. Fax Cover Sheet with Certificate of Transmission under 37 CFR 1.8 (1 pg.).

Total pages (including this paper): 10

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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DEC 06 2004

PTO/SB/17 (10-04v2)

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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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**FEE TRANSMITTAL
for FY 2005**

Effective 10/01/2004. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 110

Complete if Known

Application Number	10/054,498
Filing Date	01/22/2002
First Named Inventor	John B. Welsh
Examiner Name	UNGAR, SUSAN NMN
Art Unit	1642
Attorney Docket No.	P0026US20

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money ☐ Other ☐ None☒ Deposit Account:Deposit
Account
Number

50-1885

Deposit
Account
NameGenentech Institute of the Novartis Research
Foundation

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) or any underpayment of fee(s)
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 790	2001 395	Utility filing fee	
1002 350	2002 175	Design filing fee	
1003 550	2003 275	Plant filing fee	
1004 790	2004 395	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1)

(\$ 0)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
20	0	0	0
Independent Claims	0	0	0
Multiple Dependent	0	0	0

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1202 18	2202 9	Claims in excess of 20	
1201 88	2201 44	Independent claims in excess of 3	
1203 300	2203 150	Multiple dependent claims, if not paid	
1204 88	2204 44	** Reissue independent claims over original patent	
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2)

(\$ 0)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	2053 65	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	110
1252 430	2252 215	Extension for reply within second month	
1253 980	2253 490	Extension for reply within third month	
1254 1,530	2254 765	Extension for reply within fourth month	
1255 2,080	2255 1,040	Extension for reply within fifth month	
1401 340	2401 170	Notice of Appeal	
1402 340	2402 170	Filing a brief in support of an appeal	
1403 300	2403 150	Request for oral hearing	
1451 1,510	2451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,370	2453 685	Petition to revive - unintentional	
1501 1,370	2501 685	Utility issue fee (or reissue)	
1502 490	2502 245	Design issue fee	
1503 660	2503 330	Plant issue fee	
1460 130	2460 130	Petitions to the Commissioner	
1807 50	2807 50	Processing fee under 37 CFR 1.17 (g)	
1806 180	2806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 790	2809 395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810 790	2810 395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801 780	2801 395	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$ 110)

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)

Hugh Wang

Registration No. (Attorney/Agent)

47,163

Telephone

858-612-1539

Signature

Date

December 6, 2004

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PTO/SB/17 (10-04v2)
Approved for use through 07/31/2008. OMB 0851-0032
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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FEE TRANSMITTAL for FY 2005

Effective 10/01/2004, Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 110

Complete if Known

Application Number 10/054,488

Filing Date 01/22/2002

First Named Inventor John B. Smith

Examiner Name UNGA SVS NM

Art Unit 1842

Attorney Docket No. P0026US20

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit
Account
Number

60-1885

Deposit
Account
Name

Genomics Institute of the Novartis Research
Foundation

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments
☒ Charge any additional fee(s) or any underpayment of fee(s)
☐ Charge fee(s) indicated below, except for the filing fee
to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
		1001	790	Utility filing fee	
		1002	350	Design filing fee	
		1003	550	Plant filing fee	
		1004	790	Reissue filing fee	
		1006	180	Provisional filing fee	
SUBTOTAL (1)					(\$ 0)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
		1202	18	Claims in excess of 20	
		1201	68	Independent claims in excess of 3	
		1203	300	Multiple dependent claim, if not paid	
		1204	68	Reissue independent claims over original patent	
		1205	18	Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$ 0)

*or number previously paid, if greater. For Reissues, see above

3. ADDITIONAL FEES


Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
		1051	130	Surcharge - late filing fee or oath	
		1052	50	Surcharge - late provisional filing fee or cover sheet	
		1053	130	Non-English specification	
		1812	2,520	For filing a request for ex parte reexamination	
		1804	920*	Requesting publication of SIR prior to Examiner action	
		1805	1,840*	Requesting publication of SIR after Examiner action	
		1251	110	Extension for reply within first month	110
		1252	430	Extension for reply within second month	
		1253	980	Extension for reply within third month	
		1254	1,530	Extension for reply within fourth month	
		1255	2,080	Extension for reply within fifth month	
		1401	340	Notice of Appeal	
		1402	340	Filing a brief in support of an appeal	
		1403	300	Request for oral hearing	
		1451	1,510	Petition to institute a public use proceeding	
		1452	110	Petition to revive - unavoidable	
		1453	1,270	Petition to revive - unintentional	
		1501	1,370	Utility issue fee (or reissue)	
		1502	480	Design issue fee	
		1503	680	Plant issue fee	
		1480	130	Petitions to the Commissioner	
		1807	50	Processing fee under 37 CFR 1.17 (g)	
		1806	180	Submission of Information Disclosure Stmt	
		8021	40	Recording each patent assignment per property (times number of properties)	
		1809	790	Filing a submission after final rejection (37 CFR § 1.128(a))	
		1810	790	For each additional invention to be examined (37 CFR § 1.129(b))	
		1801	790	Request for Continued Examination (RCE)	
		1802	800	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 110)

SUBMITTED BY

Name (Print/Type)	Hugh Wang	Registration No. (Attorney/Agent)	47,183	Telephone	858-812-1539
Signature				Date	December 6, 2004

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PTO/SB/21 (09-04)


Approved for use through 07/31/2006. OMB 0851-0031

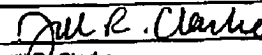
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM		Application Number	10/054,498
		Filing Date	01/22/2002
		First Named Inventor	John B. WELSH
		Art Unit	1642
		Examiner Name	UNGAR, SUSAN NMN
(to be used for all correspondence after initial filing)		Attorney Docket Number	P0026US20
Total Number of Pages in This Submission		10	

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Form PTO/SB/17 Fee Transmittal with authorization to charge Deposit Account No. 50-1885 in the amount of \$110 for one month extension of time (1 pg. + 1 pg. copy); Response to Restriction Requirement mailed October 5, 2004 (6 pgs.); Certificate of Facsimile Transmittal (1 pg.)
Remarks: The Director is authorized to charge any additional fees to Deposit Account No. 50-1885. A one-month extension of time to reply to the Restriction Requirement mailed on October 5, 2004 is respectfully requested.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm	Genomics Institute of the Novartis Research Foundation	
Signature		
Printed Name	Hugh Wang	
Date	December 6, 2004	Reg. No. 47,163

CERTIFICATE OF TRANSMISSION			
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office at facsimile number (703) 872-9306 on the date indicated below.			
Signature		Date	December 6, 2004
Typed or printed name	Jill R. Clarke		

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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By: _____

Jill R. Clarke

DEC 06 2004 PATENT
Attorney Docket No.: P0026US20

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John B. WELSH *et al.*

Application No.: 10/054,498

Filed: January 22, 2002

For: GENES OVEREXPRESSED IN
PROSTATE DISORDERS AS
DIAGNOSTIC AND
THERAPEUTIC TARGETS

Examiner: Susan Ungar, Ph.D.

Art Unit: 1642

Response to Restriction RequirementMail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

This is submitted in response to the Restriction Requirement mailed October 5, 2004 in the above-captioned patent application. A one-month extension of time is requested with this reply. Applicants request reconsideration of the Requirement for Restriction.

The Restriction Requirement restricted the pending claims into 10 separate groups. In addition, it alleged that there are 4.5×10^{105} different inventions in each group. It required Applicants to elect one of the groups and also one invention from the alleged 4.5×10^{105} different inventions. The basis for the restriction was that "Tables 2, 3 and 4 consist of 73